

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Nobutaka NAKASHIMA, *et al.*
Title: PROCESS FOR PRODUCING RECOMBINANT PROTEIN IN
BACTERIUM BELONGING TO THE GENUS RHODOCOCCUS
Appl. No.: 10/553,979
International
Filing Date: 04/19/2004
371(c) Date: 10/20/2006
Examiner: Michele K. Joike
Art Unit: 1636
Confirmation
Number: 7959

RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the restriction requirement set forth in the Office Action mailed December 14, 2007, Applicant hereby provisionally elects Group 3, comprising SEQ ID NOS: 107 and 101. The claims readable on the selected sequence are 1-9. This election is made with traverse.

Applicant respectfully submits that the PTO erred in requiring a restriction between all of the claims. Under PCT Rule 13.2, the requirement of unity of invention under PCT Rule 13.1 is fulfilled as follows:

[T]he requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

In other words, each putative invention must have at least one element in common, itself unencumbered by a *prima facie* showing of unpatentability over the prior art.

In this case, the PTO has restricted the claims based on the sequences listed in claim 5, as evidenced by the statement "Group 1 comprises SEQ ID NOs: 107 and 99, Group 2 comprises SEQ ID NOs: 107 and 100...and Group 8 comprises SEQ ID NOs: 107 and 106." Office Action, pg. 2. Consequently, it appears that each group contains claims 1-9 and SEQ ID NO: 107 but a different sequence from the group of SEQ ID NOS: 99-105.

In light of PCT 13.2 above, this restriction cannot be sustained. Claim 5 is dependent upon claim 1, which is directed to a DNA comprising a nucleotide sequence of a mutated *TipA* gene promoter, where a mutation is introduced into a -10 region sequence of the promoter. Accordingly, such DNA is a special technical feature that links claims 1 and 5. The PTO has not alleged, let alone shown, that a DNA thus prescribed is *prima facie* unpatentable over the prior art. Unity of invention is not lacking under PCT 13.2, therefore, and the PTO's restriction requirement is improper.

Claim 5 also is dependent upon claim 4, which recites a constitutive expression vector. The PTO has not shown that the constitutive expression vector is unpatentable over the art. Accordingly, the rationale set out above likewise mandates a unity of invention between claims 4 and 5, belying the restriction requirement.

Withdrawal of the restriction is requested. The Commissioner also is authorized to charge any additional fees, which may be required under 37 CFR §§ 1.16-1.17, and to credit any overpayment to Deposit Account No. 19-0741. Should no proper payment accompany this response, then the Commissioner is authorized to charge the unpaid amount to the same deposit account. If any extension is needed for timely acceptance of submitted papers, applicants petition for such extension under 37 CFR §1.136 and authorize payment of relevant fees from the deposit account.

Respectfully submitted,

Date 13 February 2006

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